



Paper No. 9

Dara L. Onofrio
233 Broadway
Suite 2702
New York, NY 10279-2799

COPY MAILED**FEB 05 2002****OFFICE OF PETITIONS**

In re Application of
Rolf Steiger et al.
Application No. 09/336,462
Filed: June 18, 1999
Attorney Docket No. ICH-286

:
:
: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.183
:

This is a decision on the petition under 37 CFR 1.183 filed on January 7, 2002, requesting that the requirement to pay the extension of time fee in the above-identified application be waived.

A first Office action was mailed in the above-identified application on June 15, 2001, setting a three-month shortened statutory period for reply. In response, on January 7, 2002, applicant filed an amendment and a petition under 37 CFR 1.183, and in the alternative, petition for extensions of time.

Petitioner argues that the extension of time fee should be waived because due to the events of September 11th and aftermath, a timely response to the Office action was unable to be filed prior to the expiration of the shortened statutory period. In the petition, the petitioner states that the office of the applicant's attorney was located in a building two blocks away from the World Trade Center; the telephone and electricity services in the attorney's office were interrupted; and the mail to the attorney's office was delayed due to "anthrax" threats. Petitioner requests that the extension of time fees be waived due to these extra-ordinary circumstances.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h). (Emphasis added).

35 U.S.C. 41(a) (8) states that:

The Director shall charge the following fees:

...

(8) For petitions for 1-month extensions of time to take actions required by the Director in an application-

(A) on filing a first petition, \$110

(B) on filing a second petition, \$270; and

(C) on filing a third or subsequent petition, \$490. (Emphasis added)

Since the requirement to pay the extension of time fee is a requirement of the statute, the Commissioner is without authority to waive this requirement. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of the statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The payment of the statutory fee is obligatory upon the applicant and the collection of the statutory fee is likewise obligatory upon the Office. Boyden v. Commissioner of Patents, 441 F.2d 1041, 1043, 168 USPQ 680, 681 (D.C. Cir. 1971), cert. denied, 404 US 842, 171 USPQ 321 (1971). The Office has no discretion to proceed in the absence of such payment.

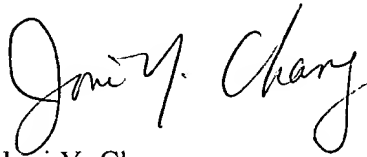
While it is unfortunate that applicant was unable to file the amendment prior to the expiration of the shortened statutory period due to the events of September 11th and aftermath, the Office is without authority to waive the extension of time fee.

In view of the above, the petition to waive the requirement to pay the extension of time fee is dismissed.

After mailing of this decision, the \$130.00 petition fee for the petition under 37 CFR 1.183 and the three-month extension of time fee of \$920.00 will be charged to counsel's deposit account No. 50-1541 as authorized in the petition.

The application is being returned to Technology Center Art Unit 1774 for consideration by the examiner of the amendment filed January 7, 2002.

Inquiries concerning this decision may be directed to the undersigned at (703) 308-3858.



Joni Y. Chang
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy